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In the Supreme Court of the United States

OCTOBER TERM, 1963.

No. 618.

GENERAL MOTORS CORPORATION, METAL LUBRICANTS CO., HOUDAILLE INDUSTRIES, INC.,

Petitioners,

vs.

DEVEX CORPORATION, WILLIAM C. McCOY, THEODORE A. TeGROTENHUIS,

Respondents.

BRIEF IN OPPOSITION TO THE PETITION.

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COUNTER-STATEMENT.

(a) These are ordinary patent infringement cases. The judgment sought to be reviewed* is not final or "final except for accounting"; 28 U. S. C. 1292(4). The cases were consolidated for trial on the common issue of validity under Rule 42(a) F. R. C. P. and validity is the only issue which has been tried to date (Pet. 37). All issues of infringement are to be tried subsequently and separately (Pet. 5).

(b) PETITIONERS' QUESTION 1 (Pet. 2-3): There was no anticipating prior public use at Briggs (Pet. 9-13). The Court of Appeals was correct as a matter of law in holding that petitioners did not meet their burden of proof

* The petition does not comply with Rule 23(1)(j) of this Court in that no copy of the judgment of the Court of Appeals is appended.

(Pet. 35-6) and in holding, on undisputed evidence, that what happened at Briggs was so transitory, fortuitous and trivial in its nature and extent that it did not constitute a prior use within the meaning and intent of 35 U. S. C. 102(a) (Pet. 36).

Contrary to petitioners' assertions and to the thrust of Question 1, the Court of Appeals did not bottom its rejection of the Briggs defense on the Henricks affidavit. It dealt first with the failure of petitioners' proofs and the insufficiency of the alleged use as an anticipation under 35 U. S. C. 102 (Pet. 35-6). It then went on to say that the District Judge should have considered the affidavit (Pet. 37); it was manifestly proper for the Court of Appeals to emphasize, in this fashion, the failure of petitioners to meet their burden of proof.

Question 1 is purely academic: the petition nowhere proffers or asserts any facts which would lead to a different result if the case is remanded to the District Court for a new trial. Nor did petitioners do so in either of the courts below.

(c) PETITIONERS' QUESTION 2 (Pet. 3): Petitioners' assertion that the accused process "operates in a manner and with a result directly contrary to" the patented process (Pet. 11, 15-7) is untrue. The specific question—hardly one for review by this Court—is whether the use and manner of use of chemical compositions supplied to petitioners by Parker Rust Proof Company (which is defending the action; Pet. 31) for lubricating the work pieces and the dies in a metal-forming operation, leaves a coating on the formed piece which can be removed by ordinary cleaning methods (as respondent proved) or whether the coating is insoluble (as petitioners assert).

Petitioners' assertion is directly contrary to Parker Rust Proof's published technical specifications and the admissions of petitioners' expert witness at the trial (Ptf. App. 57, 66). Petitioners' only argument for indefiniteness is therefore ill founded in fact and the Court of Appeals was right in holding that the claim meets the requirements of 35 U. S. C. 112 (Pet. 31-2).

(d) PETITIONERS' QUESTIONS 3 AND 4 (Pet. 3-4): None of the thirty-one references relied upon by Petitioners anticipate the patent in suit (Pet. 32). The acts at Briggs were those of the patentee himself and therefore no question of inventorship arises. Question 3 is redundant and does not present any question additional to those presented by Questions 1 and 4.

The trial court recognized that the patent in suit did make a stride forward in the art but apparently thought it was not sufficient to merit a patent (Pet. 35). The Court of Appeals reviewed the history of the art in general (Pet. 26-9) and of Parker Rust Proof in particular (Pet. 33-4); pointed to undisputed evidence showing that Henricks had achieved new, valuable and unexpected results (Pet. 30-1); noted that despite the aid given to Parker Rust Proof by its own competitors (Pet. 31) no better art than that considered by the Patent Office had been found (Pet. 33-4) and that the process had not in fact been "obvious to the defendants and the others now associated with them in the defense of this suit" (Pet. 33-4); and on these facts, all established by undisputed evidence, properly held that all requirements for patentability under 35 U. S. C. 103 had been met.

ARGUMENT.

The "Questions Presented," on their face, are not questions of the sort which should or need be considered by this Court; Rule 19(1)(b); *Magnum Import Co. v. Coty* (1923) 262 U. S. 159, 163; *Layne & Bowler Co. v. Western Well Works*, (1923) 261 U. S. 387, 392-3; *Forsyth v. Hammond* (1897) 166 U. S. 506, 513-4. The matters hereinabove recited plainly show that the Questions are contrived ones which do not actually arise in the case.

What petitioners are really seeking is not a resolution of an unsettled or uncertain question of law or even the resolution of a factual question of general public importance but merely a second review of contentions apposite only to the particular circumstances of this case; *Keller v. Adams-Campbell Co.*, (1924) 264 U. S. 314, 319-20; *Tyrrell v. District of Columbia*, (1917) 243 U. S. 1, 6; *Furness, Withy & Co. v. Yang-Tsze Insurance Association*, (1917) 242 U. S. 430, 433-4; *United States v. Rimer*, (1910) 220 U. S. 547, 548.

The petition should be denied.

Respectfully submitted,

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